

REMARKS

In the Advisory Action the Office states:

"The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Applicant's arguments filed on December 10, 2008 were found unpersuasive for following reasons:

Applicant's arguments based on statement that: "Office has not shown that Aoyama, alone or as modified by Naylor and Kato as proposed in the Final Action, discloses a polyester resin composition which meets all of the limitations of the rejected claims. Specifically, the Office has not shown that Aoyama, alone or modified by Naylor and Kato as proposed by the office, discloses a composition that does not contain titanium-containing particles having an equivalent circular diameter of 1 micron or more or contains less than 100 titanium-containing particles per 0.02 mg of the composition having an equivalent circular diameter of 1 micron or more. This Argument based on data provided by Declaration under 37 C.F.R. 1.132 filed after Final rejection, without any reasons why this Declaration was

not presented earlier. For this reason, Declaration was found untimely and will not be entered and considered. Therefore, Applicant argument based on Declaration filed on November 13, 2008 is unpersuasive.

In addition note, that rejection based on combination of references (Aoyama combine with Naylor and Kato in this case) is not anticipatory rejection and for this reason does not need disclosed all specific elements of Applicant's claimed subject matter, but rather should render claimed subject matter obvious to one of ordinary skill.

In that case, Aoyama recognized importance of small particle sizes less than 3 micron in order "to achieve good slipperiness and adhesiveness at the time of lamination" - see column 6, lines 1-6. Thus, Aoyama provide rationale to one of ordinary skill to reduce particle size less than 3 micron in order to achieve good slipperiness and adhesiveness" of the composition.

In addition Applicant was advised to provide factual data in order to show unexpected benefits of the composition, wherein particles, having diameter is larger than 1 micron present in specific amount claimed by Applicant

(see Advisory mailed on January 4, 2008) compare with composition disclosed by Aoyama as the most closes [sic, closest] prior art of the record. Sop [sic] far no such results were presented by Applicant.

Applicants respectfully submit that the statements in the Action are not proper and demonstrate the impropriety of the Office's position. The improprieties of the Office's position are explained below with reference to statements in the Action.

(1) "Aoyama recognized importance of small particle sizes less than 3 micron in order "to achieve good slipperiness and adhesiveness at the time of lamination" - see column 6, lines 1-6. Thus, Aoyama provide rationale to one of ordinary skill to reduce particle size less than 3 micron in order to achieve good slipperiness and adhesiveness" of the composition."

To support a rejection of claims of an application under 35 U.S.C. § 102 or 35 U.S.C. § 103(a), the prior art must be enabling. The Office has failed to cite teachings in Aoyama or the prior art that would enable a person of ordinary skill in the art to modify the method of Aoyama so as to obtain a polyester resin composition which meets the particle size limitations of the claims of the present application.

Naylor has been cited only as teaching that the reaction product prepared by allowing an alkyl titanate to react with lactic

acid or citric acid is preferable for the production of film or bottle grade resin, because it allows the production of a resin with a low haze value and good color due to inhibition of titanium precipitation.

Kato has been cited only as teaching that ethyl diethylphosphonoacetate can be preferably used for preventing coloration and enhancing melt stability of a polyester resin composition.

Moreover, applicants have previously explained that Aoyama cannot satisfy the particle size limitations specified in claim 1 of the present application required for a polyester resin composition to be useful for a magnetic recording medium that requires high surface smoothness. Specifically, in the invention of Aoyama, a composite oxide is a slurry and is added as a slurry as described in Example 1 (column 14, line 29). The use of such a slurry will not produce a polyester resin composition that meets the requirement of the claims of the present application that "the number of titanium-containing particles having an equivalent circular diameter of 1 μm or more is less than 100/0.02 mg."

This fact is demonstrated by the data of the declaration under 37 C.F.R. § 1.132 of Koichi DAN that is submitted herewith as part of the submission under 37 C.F.R. § 1.114. The data show that none

of the compositions of the examples of Aoyama meet the limitation that the number of titanium-containing particles having an equivalent circular diameter of 1 μ m or more is less than 100/0.02 mg of the composition, as required by the claims of the present application.

IF THE OFFICE MAINTAINS ITS POSITION THAT THE COMBINATION OF AOYAMA WITH NAYLOR AND KATO SUPPORT THE OBVIOUSNESS OF THE POLYESTER RESIN COMPOSITION OF THE PRESENT INVENTION, IT IS RESPECTFULLY REQUESTED TO IDENTIFY THE SPECIFIC MODIFICATIONS TO AOYAMA SUPPORTED BY THE TEACHINGS OF THE PRIOR ART THAT WOULD HAVE ENABLED A PERSON OF ORDINARY SKILL IN THE ART TO PRODUCE THE COMPOSITION.

(2) "In addition Applicant was advised to provide factual data in order to show unexpected benefits of the composition, wherein particles, having diameter is larger than 1 micron present in specific amount, claimed by Applicant (see Advisory mailed on January 4, 2008) compare with composition disclosed by Aoyama as the most closes [sic, closest] prior art of the record. Sop [sic] far no such results were presented by Applicant."

This statement is not understood. Applicants have previously explained that the comparative data in the present application show that less than 100/0.02 mg of the polyester resin composition of titanium-containing particles having an equivalent circular

diameter of 1 μm or more is material to obtaining a composition having good castability and a reduced number of dropouts. (Comparative Examples 1 and 4 in Tables 1-1 and 1-2). These data demonstrate criticalness for the number density of titanium-containing particles having an equivalent circular diameter of 1 μm or more as recited in the claims and rebut any prima facie obviousness alleged by the Office to be supported by the combination of Aoyama, Naylor and Kato.

THE OFFICE MUST CONSIDER THE COMPARATIVE DATA IN THE APPLICATION AND THE OFFICE IS RESPECTFULLY REQUESTED TO PROVIDE REASONS EXPLAINING WHY THE COMPARATIVE DATA IN THE APPLICATION ARE NOT SUFFICIENT TO SHOW CRITICALNESS FOR THE NUMBER DENSITY LIMITATION.

The Office suggests in the Advisory Action that a comparison with the composition disclosed by Aoyama is required. However, such a comparison is not required if the comparative examples in the specification are closer to the polyester composition of the present invention than is the composition of Aoyama. MPEP 706.02(e)(I) ("Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner. *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd.

App. 1961) (Claims to a 13-chloro substituted compound were rejected as obvious over nonchlorinated analogs of the claimed compound. Evidence showing unexpected results for the claimed compound as compared with the 9-, 12-, and 14- chloro derivatives of the compound rebutted the prima facie case of obviousness because the compounds compared against were closer to the claimed invention than the prior art relied upon.)").

In the present case Comparative Examples 1 and 4 are closer to the claimed invention than the compositions of Aoyama because, first, the number of particles (No./0.02 mg) of each of Comparative Examples 1 and 4 is closer to the claimed limitation than the number of such particles of the compositions of Aoyama as shown in the DAN declaration.

Second, the compositions of Comparative Examples 1 and 4 differ from the claimed compositions only with respect to the titanium content (Comparative Example 1) and amount of ethyl diethylphosphonoacetate (Comparative Example 4).

For the above reasons, the 35 U.S.C. § 103(a) rejections of the claims are improper and should be removed.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of

PATENT APPLN. NO. 10/529,847
SUBMISSION UNDER 37 C.F.R. § 1.114

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time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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